



PATENT
Customer No. 22,852
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Attention: Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER BOARD RULE § 41.41

Pursuant to Board Rule 37 C.F.R. § 41.41, Appellant presents a Reply Brief to the Examiner's Answer dated April 27, 2006. Because this Reply Brief is filed within two months of the Examiner's Answer, i.e., on or before June 27, 2006, it is timely. If any additional fees are required or if the enclosed payment is insufficient, Appellant requests that the required fees be charged to Deposit Account No. 06-0916.

REMARKS

In response to the revised Appeal Brief filed on March 13, 2006,¹ the Office continues to maintain that the declaration of Mme. RONDEAU submitted under 37 C.F.R. § 1.132 is insufficient to overcome the rejection of claim 1-42 based on Cotteret in view of Mockli and the rejection of claims 1-23, 32-36, 41, and 42 based on Kao in view of Mockli. Examiner's Answer at pages 7-13. Appellant continues to respectfully disagree for the reasons of record and the additional reasons presented below.

The main argument posed by the Office in opposition to the RONDEAU declaration is that the compositions representative of Cotteret and Kao do not embody the teachings of the respective references and the number of inventive compositions examined are not commensurate in scope with the claimed subject matter. Examiner's Answer at page 8-13. The Office alleges that as a result, Mme. RONDEAU's declaration has no probative value. *Id.* at page 8, ll. 20, 21. To support these assertions, the Office directs Appellant to M.P.E.P. § 716.02 (d) and (e), and various case citations supporting the assertions that "objective evidence of unobvious results must be commensurate in scope with the claims" and "where unobvious results are relied upon as a basis for patentability, a proper comparative showing is a minimum requirement." *Id.* at page 9, ll. 9-14.

Appellant agrees with the citations to the M.P.E.P. and case law provided by the Office but does not agree with the Office's interpretation and application thereof in view of RONDEAU's declaration and the cited art. Namely, the Office's contentions focus on

¹ Appellant filed the original Appeal Brief on December 20, 2005.

RONDEAU's declaration being used to demonstrate *unexpected results*. Appellant, however, did not submit RONDEAU's declaration to demonstrate unexpected results, as evidenced in the Appeal Brief and the prosecution history of the present invention. Appeal Brief at page 13, 17, 22, 23; see Response to Office action dated May 26, 2004, filed October 26, 2004.

To the contrary, Appellant asserts that RONDEAU's declaration demonstrates the lack of a motivation to combine (i.e., the general compatibility of these ingredients cannot serve as a source of motivation to combine) and the absence of a reasonable expectation of success (i.e., the variability known in the art). In other words, the declaration is relied on by Appellant not to rebut a *prima facie* case of obviousness by showing unexpected results but to show that a *prima facie* case was never made successfully in the first place. At most, the primary references of Cotteret and Kao offer an invitation to experiment, which is not enough to establish a *prima facie* case of obviousness. The Office, however, ignores these challenges to the establishment of a *prima facie* case of obviousness by stating that the Board of Appeals affirmed the rejections in the decision in the parent case, Application No. 09/278,176, on November 25, 2003. Examiner's Answer at page 7. "Facts established by rebuttal evidence must be evaluated along *with the facts on which the conclusion of obviousness was reached*, not against the conclusion itself." M.P.E.P. § 2142 (citing *In re Eli Lilly & Co.*, 902 F.2d 943, 14 U.S.P.Q.2d 1741 (Fed. Cir. 1990) (emphases added)). RONDEAU's declaration challenges those facts.

A. Cotteret in view of Mockli

Under the Office's rationale, a motivation to combine Cotteret in view of Mockli exists because Mockli "teaches that said dyes are compatible with the cationic polymers ... that Cotteret uses" and Cotteret "teaches that the claimed polymers result in various improved properties such as improved selectivity when used in oxidation dyeing compositions." Examiner's Answer at page 4. This is similar to the rationale found in the parent application. In the parent case, the Board affirmed the Examiner and indicated that "Cotteret teaches that direct dyes, in general, may be added to the oxidation dye compositions comprising the presently claimed cationic or amphoteric substantive polymers, and Mockli also teaches that Appellant's cationic direct dyes may be formulated with cationic conditioning polymers . . ." Appeal No. 2003-1308 at page 5. Appellant challenges those assertions in view of the comparison data presented in RONDEAU's declaration, i.e., the comparison of Composition B with the Inventive Composition. See Appeal Brief at pages 13-17.

Specifically, Cotteret teaches improving properties stemming from the use of cationic or amphoteric substantive polymers when combined with particular oxidation bases. Cotteret at Col. 1, ll. 50-56. How does an improvement seen in the combination of particular substantive polymers and particular oxidation bases relate to the inclusion of a direct dye? Direct dyes are commonly known to modify shades of color but with the inventive composition, one is not just using any direct dye. Instead, the inventive composition is directed to particular cationic direct dyes and particular cationic

substantive polymers. Thus, the general teaching in Cotteret in this instance is not enough.

In fact, the Board decision in the parent application admits that Cotteret teaches a “general” approach; “Cotteret teaches that direct dyes, *in general*, may be added to the oxidation dye compositions comprising the presently claimed cationic or amphoteric substantive polymers.” Appeal No. 2003-1308 at page 5 (emphasis added). The Board, moreover, points to Cotteret, not Mockli, as providing the teaching of using direct dyes with oxidation compositions. *Id.* at pages 5, 6. This type of disclosure offers an invitation to experiment, i.e., “obvious to try” rationale. As provided in the present specification, in the hair dyeing art, it is known that not all direct dyes have the same effects and in fact, some may lead to insufficient colorations. For example, the present specification provides that

[a]mong the cationic direct dyes available in the field of dyeing keratin fibers, especially human keratin fibers, the compounds whose structure is developed in the following text are already known; however, these dyes lead to insufficient colorations, both regarding the homogeneity of the color distributed along the fiber (“unison”), where the coloration is said to be too selective, and regarding the staying power, where the hair resists various attacking factors, including light, bad weather, and shampooing.

Specification at page 2 (emphasis added). Thus, the “general” teaching in Cotteret merely invites experimentation and does not teach or suggest anything other than trying all direct dyes.

RONDEAU’s declaration actually puts to use this “general” teaching found in Cotteret. Taking into consideration the Office’s and the Board’s reliance on Cotteret for its teaching of the cationic or amphoteric substantive polymer, Appellant used Cotteret’s

substantive polymer (hexadimethrine chloride, Cotteret at Formula (II)) in combination with a “general” direct dye; in this case, the direct dye was 2,2’-[[4-[(4-aminophenyl)azo]-3-methylphenyl]imino]bis-ethanol (HC Yellow 7) to form Composition B. Comparing Composition B to the Inventive Composition under the same test conditions, Mme. RONDEAU found that Composition B produced a greater color variation, which means it produced a less selective color on the hair fibers. The Office, however, purports to find this explanation unclear as to how color variation “relates to the more homogenous color along the keratin fiber.” Examiner’s Answer at page 9. As detailed in RONDEAU’s declaration at page 4, by comparing the intensity, i.e., lightness (L^* , L^*_0), and quality of color (chromaticity) both before and after dyeing, one can determine the color variation or the dye’s ability to produce a homogenous color distributed along the hair fiber.

In addition, the Office misapprehends the scope of Cotteret’s teachings. Cotteret does not teach a composition for the oxidation dyeing of keratin fibers of particular cationic or amphoteric substantive polymers with particular cationic direct dyes. Examiner’s Answer at page 3. In fact, the Office admits that “Cotteret fails to teach the addition of the specific direct dyes as claimed.” *Id.* The only way the Office is able to import into Cotteret’s composition specific direct dyes is by relying on Cotteret’s general teaching “that the claimed [cationic substantive] polymers result in various improved properties such as improved selectivity when used in oxidation dyeing compositions.” *Id.* at page 4. This is where the misapprehension occurs. This teaching clearly relates to the substantive polymers, not to the inclusion of cationic direct dyes or even the specific direct dyes as claimed. Thus, Cotteret teaches improved properties of a

composition with respect to a particular ingredient and not in its entirety. See *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

Accordingly, Appellant maintains that the Office has failed to establish a prima facie case of obviousness and respectfully requests the withdrawal of the rejection.

B. Kao in view of Mockli

As in the rejection in view of Cotteret and Mockli, the Office presents a similar rationale as to why the RONDEAU declaration fails to provide sufficient evidence of unexpected results to overcome the rejection of record in view of Kao and Mockli. Examiner's Answer at pages 5-11. Appellant again stresses that RONDEAU's declaration provides evidence that the general teachings in Kao are not sufficient to provide a suggestion or a motivation to combine specific cationic substantive polymers with specific cationic direct dyes to overcome at least one of the deficiencies in the art.

As explained by the Office, Kao provides a composition of a direct dye and a hydroxyalkyl guar gum. Examiner's Answer at page 5. Kao teaches that "the cationic (basic) dyes are particularly preferred since their stability and dye uptake properties are especially enhanced by the addition of the guar gum derivative according to the invention." Kao Translation at page 2. Kao also teaches the optional inclusion of conditioning polymers such as cationic polymers. *Id.* The Office relies on the beneficial properties attributed to the cationic direct dyes as a means to import Mockli's particular cationic direct dyes. This is even in spite of the fact that admittedly, "Kao does not teach cationic direct dyes of the claimed formulae." Examiner's Answer at page 5.

RONDEAU's declaration again puts to use these general teachings in Kao.

Taking into consideration the Office's and the Board's reliance on Kao for its teaching of all direct-acting hair dyes and in particular, a cationic direct dye, Appellant used a cationic direct dye (Basic Orange 31) in combination with a guar gum to form Composition A. The Office takes issue with this composition because it lacks a polymer suggested on page 4, third paragraph of Kao (i.e., specific conditioning polymers of dimethyldiallyl ammonium chloride and cationic vinylpyrrolidone). Examiner's Answer at page 10. According to the Office, Composition A is not the composition taught in Kao on which the rejection is based. *Id.*

As provided in Appellant's specification, the substantive cationic/amphoteric polymer in the inventive composition assists in "giving colorations that are less selective and that show good resistance to the various attacking factors to the hair." Appellant's Specification at page 2. In a similar manner, Kao states that "the color intensity, that is, the ability to absorb dye, is substantially improved, compared to current products, by the addition of the hydroxyalkyl guar gum derivative; the product also exhibits excellent stability." Kao at page 1. Accordingly, both polymers arguably have a similar purpose. This similarity in purpose is ignored by the Office. Thus, it is unclear why "conditioning polymers" are chosen, but for Appellant's teachings in the specification.

In essence, the Office is requiring Appellant to compare a composition having specific ingredients where the only possible teaching or suggestion directing a person of ordinary skill in the art to those particular ingredients is in Appellant's specification. See *In re Chapman*, 357 F.2d 418, 422, 148 U.S.P.Q. 711, 714 (C.C.P.A. 1966) (requiring an applicant to compare the claimed invention with a polymer suggest by the

combination of references "would amount to requiring comparison of the results of the invention with the results of the invention," which is not required for comparative testing.).

From RONDEAU's color variation data in the declaration, the Kao composition in view of the inventive composition demonstrates the variability between different dye compositions. This variability indicates that Kao's general disclosure of any dye or even "preferred" cationic direct dyes and even further, with optional ingredients such as conditioning polymers, is just a general approach without any guidance as to what combination of ingredients provides dye compositions that give less selective (i.e., more homogeneous) coloration and that provides colorations that show good resistance to the various attacking factors. A general approach, however, cannot support a motivation to combine, especially in view of the variability demonstrated in RONDEAU's declaration. See *In re O'Farrell*, 853 F.2d 894, 70 U.S.P.Q.2d 1673 (Fed. Cir. 1988). Instead, this variability suggests that there is a lack of predictability in the art and the need for more specific guidance as to the particular elements in comparison to broad disclosures of classes of elements.

CONCLUSION

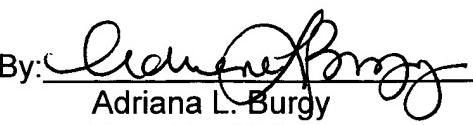
As set forth in the Appeal Brief and further provided herein, Appellant maintains that a *prima facie* case of obviousness has not been established by the Office based on the cited references. The Office failed to demonstrate that a motivation to combine the cited references and a reasonable expectation of success given the variability known in the art. Thus, pending claims 1-42 are allowable and reversal of the Examiner's rejections is respectfully requested.

To the extent any extension of time under 37 C.F.R. § 1.136(b) is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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